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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,672	06/29/2006	Werner Bonrath	4662-189	4996
23117	7590	12/05/2008	EXAMINER	
NIXON & VANDERHYE, PC			GALE, KELLETTE	
901 NORTH GLEBE ROAD, 11TH FLOOR			ART UNIT	PAPER NUMBER
ARLINGTON, VA 22203			1621	
MAIL DATE		DELIVERY MODE		
12/05/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/582,672	<b>Applicant(s)</b> BONRATH ET AL.
	<b>Examiner</b> KELLETTE GALE	<b>Art Unit</b> 1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 August 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) 11,12,21 and 22 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10 and 13-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/95/08)  
Paper No(s)/Mail Date 8/20/2008

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Status of Claims***

Claims 1-22 are pending in this application.

Claims 1-10 and 13-20 are under prosecution in this application.

Claims 11-12 and 21-22 are withdrawn as nonelected subject matter.

Claims 1-10 and 13-20 have been rejected in this office action.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 20, 2008 has been entered.

***Response to Amendment***

Applicant's amendment filed August 20, 2008 has been received and acknowledged.

***Response to Arguments***

Applicant's arguments with respect to claims 1-10 and 13-20 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-10 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al (Applied Catalysis A: General 220 (2001) 51-58) in view of Choudhary et al (US 6,437,191).

Applicant claims a process for the manufacture of 2,3,5-trimethylhydroquinone dialkionate comprising reacting ketoisophorone with an acylating agent in the presence of an indium salt catalyst and further converting it by transesterification to alpha tocopherol.

#### **Determination of the scope and content of the prior art**

**(MPEP §2141.01)**

Schneider et al teaches the process of reacting ketoisophorone with acetic acid anhydride in the presence of a Nafion Catalyst to form 2,3,5-trimethylhydroquinone diacetate (please see page 52, col. 1 and abstract). The trimethylhydroquinone diacetate is then reacted to form (all rac)-alpha-tocopherol.

Choudhary et al teach the use if indium halide as a reusable solid acylation catalyst.

**Ascertainment of the difference between the prior art and the claims  
(MPEP §2141.02)**

The difference between the prior art and the claims is that Schneider et al does not teach the use of indium salt as a catalyst in their reaction and Choudhary et al does not teach the reaction as claimed. Also, the quantitative measurements of the amount of catalyst used are not exactly the same in the prior art.

**Finding of prima facie obviousness**

**Rational and Motivation (MPEP §2142-2143)**

One having ordinary skill in the art at the time of the instant invention would find it obvious to use the indium halide as a catalyst or acylation agent in the acylation reaction as taught by Schneider et al. One would be motivated to use indium halide as a catalyst or acylation agent in the acylation reaction taught by Schneider et al since Choudhary has noted indium halide to be an acylation agent and/or catalyst. The prior art, Schneider et al, uses Nafion as the catalyst. The prior art, Choudhary et al, uses indium halide as an acylation catalyst. This is simply substitution of one known element for another to obtain predictable results since the claimed process is an acylation process. It would be obvious to use an acylation catalyst, that is-indium halide, in an acylation reaction, that is- the reaction taught by Schneider et al.

Also, merely modifying the process conditions such as temperature and concentration is not a patentable modification absent a showing of criticality. In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLETTE GALE whose telephone number is (571)272-8038. The examiner can normally be reached on M-F (6:30am-3:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DANIEL SULLIVAN can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kellette Gale  
Patent Examiner  
Technology Center 1600

November 19, 2008

/Daniel M Sullivan/  
Supervisory Patent Examiner, Art Unit 1621